

REMARKS

Claims 1-15 and 17 are currently pending. Claim 16 was canceled without prejudice. Claims 1, 6, 7, 10, and 15 are amended to more distinctly claim what Applicant regards as the present invention and are supported by the specification and claims as originally filed. No subject matter has been relinquished by such amendments. Claim 17 is new. No new matter is added by way of these amendments. Applicant reserves the right to pursue these claims, prior versions of the claims, and/or the cancelled claims in another application.

In the Office Action, the Examiner objected to claims 1, 6, 7, and 10 based on informalities and claim 15 as being of improper dependent form. The Examiner rejected claims 1-14 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner rejected claims 1-3, 5-9, and 11-16 under 35 U.S.C. § 103(a) as being obvious over Shortland et al. (International Publication WO 00/42274) (“Shortland”) in view of U.S. Patent No. 5,043,839 to Wallace (“Wallace”). The Examiner rejected claims 4 and 10 under 35 U.S.C. § 103(a) as being obvious over Shortland in view of Wallace and further in view of U.S. Patent No. 5,063,251 to Bergishagen (“Bergishagen”). For the reasons detailed below, the rejection should be withdrawn and the claims should be allowed to issue.

Applicant's Reply

In this Response, Applicant amends claims 1, 6, 7, 10, and 15, add new claim 17, and address the Examiner's rejections. Support for the amendments to the claims can be found throughout the application. Amendments to the claims are being made solely to expedite prosecution and do not constitute an acquiescence to any of the Examiner's rejections.

Applicant's silence with regard to the Examiner's rejections of the dependent claims constitutes a recognition by the Applicant that the rejections are moot based on Applicant's Amendment and Remarks relative to the independent claim from which the dependent claims depend.

I. Claim Objections

The Examiner objected to claims 1, 6, 7, 10 based on informalities. As suggested by the Examiner, Applicant has amended claim 1 to recite "a floor which the floor covering." Also as suggested by the Examiner, Applicant has amended claims 6 and 7 to recite a "decorative upper surface." As suggested by the Examiner, Applicant has amended claim 10 to recite "parts per hundred parts of plastic material" prior to using the acronym, replaced "from" with "of" on line 3, and removed the word "from" on lines 4-5. Therefore, Applicant kindly requests that these objections be removed.

The Examiner objected to claim 15 as being of improper dependent form for failing to limit the subject matter of a previous claim. Applicant has amended claim 15, canceled claim 16, and added new claim 17 and submit that the claims are now in proper form. Therefore, Applicant kindly requests that this objection be removed.

II. Rejection under 35 U.S.C. §112

The Examiner rejected claims 1-14 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that the "upper surface" lacks a sufficient antecedent basis. Applicant has amended claim 1 to recite "an upper surface" in line 1 which

provides a proper antecedent basis for the “the upper surface” in line 4. Therefore, Applicant kindly requests that this rejection be removed.

The Examiner takes the position that claim 14 is unclear as to whether the support as recited is referring to the studs or a scrim layer as disclosed in the specification. Applicant respectfully submits that support would be clear to the person of skill in the art and could be inclusive or exclusive of the studs, which may themselves provide a support function. As the Examiner notes, one embodiment of the support could be the scrim layer (25) as disclosed in the specification, but other means known to one of skill in the art could be used (such as the “reinforcing support” recited in the specification). Therefore, Applicant kindly requests that this rejection be removed.

III. Rejection under 35 U.S.C. §103(a)

Claims 1-3, 5-9, and 11-16 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shortland in view of Wallace. Claims 4 and 10 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shortland in view of Wallace and further in view of Bergishagen.

To reject claims in an application under Section 103, an examiner must establish a *prima facie* case of obviousness. Using the Supreme Court’s guidelines enunciated in *Graham v. John Deere*, 383 U.S. 1, 17 (1966), one determines “obviousness” as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, No. 04-1350 (U.S. April 30, 2007), the Supreme Court reaffirmed the *Graham* test, and indicated that although it should not be rigidity applied, a useful test for determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. Importantly, the Court emphasized that a patent examiner's analysis under Section 103 should be made explicit in order to facilitate review.

Thus, to establish a *prima facie* case of obviousness, the Examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. The Examiner must then provide: (1) an explicit, cogent reason based on the foregoing why it would be obvious to modify the prior art to arrive at the claimed invention; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claimed features. See M.P.E.P. §§ 706.02(j) and 2143. As provided herein, none of the cited references, whether considered separately or in combination, provides a lower surface on which are formed one or more studs so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor. The Examiner thus fails to provide a *prima facie* case of obviousness for at least this reason. Applicant's failure to address the other elements of 35 U.S.C. § 103(a) does not constitute an admission that such elements are satisfied, but rather a recognition that such elements are moot given the Examiner's failure to provide a showing of all the claimed features. Applicant reserves the option to comment on such elements in further prosecution.

Independent claim 1 is directed to ventilating decorative floor covering for loose laying on an upper surface of a floor that includes a decorative upper surface and a lower surface on which are formed one or more studs so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor. Neither Shortland or Wallace, considered alone or in combination, disclose or suggest a decorative floor covering with this recited combination of elements.

Assuming, *arguendo*, that there was a reasonable expectation of success and a motivation to combine Shortland and Wallace, the combination still would fail to disclose or suggest all elements of claim 1 as amended, which recites a ventilating decorative floor covering including “a lower surface on which are formed one or more studs so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor.”

In the Office Action, the Examiner takes the position that “the limitation ‘provide an air gap between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor’ is related to an intended use and is given little patentable weight.” (Office Action, page 4). While Applicant does not agree with this position, Applicant has amended claim 1 to more clearly recite that “an air gap is formed.” Neither Shortland or Wallace, considered alone or in combination, describe a lower surface on which are formed one or more studs so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor.

The Examiner admits that Shortland does not disclose one or more studs formed on the lower surface of a floor covering. (Office Action, page 4). The Examiner takes the position that Wallace discloses a floor structure having studs (24). Applicant, however,

respectfully disagrees. Wallace is directed to a flooring structure that controls electrostatic charges. The flooring structure includes a bottom layer 14 of interlocking modular cushion tiles 16 comprising a planar body 22 and separate support members 24. (See Wallace, col. 5, lines 14-19). This arrangement of interlocking tiles with support members 24 is completely different than a “lower surface on which are formed one or more studs,” as claim 1 recites. Alternatively, Wallace discloses a bottom layer 14 using a piece of plywood as planar body 22 on top of wood members “two-by-fours” as support members 24. (See Wallace col. 5, lines 26-32). An arrangement of connected wood pieces is completely different than a “lower surface on which are formed one or more studs,” as claim 1 recites.

Additionally, Shortland or Wallace, either alone or in combination, do not disclose an arrangement “so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor.” As admitted by the Examiner, Shortland does not disclose any studs on the lower surface and therefore also does not disclose any air gap. Wallace discloses that conductive foam material 50 is placed under the planar body 22 of modular cushion tiles 16 in the space between support members 24. (See Wallace, col. 6, lines 62-65). Therefore, Wallace does not disclose or suggest an air gap between the lower surface of the floor covering and the upper surface of the floor because any space is filled with foam material. For at least these reasons, Shortland and Wallace, either alone or in combination, do not disclose or suggest all the elements of claim 1.

Since claim 1 is allowable, claims 2-14 depending therefrom are also allowable.

Independent claim 15, as amended, is directed to a method of laying a floor covering as defined in claim 1. Therefore, claim 15 is patentable over the cited art for at least the same reasons as discussed above with respect to claim 1.

Since claim 15 is allowable, claim 17 depending therefrom is also allowable.

IV. CONCLUSION

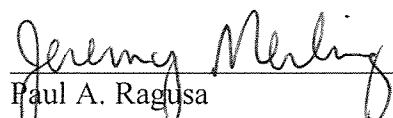
Entry of the foregoing amendments and remarks into the file of the above-identified application is respectfully requested. Applicant believes that claims 1-15 and 17 are in condition for allowance. Withdrawal of all rejections and reconsideration of the amended claims is requested. An early allowance is earnestly sought.

Applicant believes that no additional fees are due in the timely filing of this response. In the event that fees are due, or overpayment is made, however, the Director is hereby authorized to charge payment of any such fees, or to credit any overpayment, to Deposit Account No. 02-4377.

If there are any remaining issues to be resolved, Applicant respectfully requests that the Examiner kindly contact the undersigned attorney for early resolution.

Respectfully submitted,

Dated: August 7, 2007


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